

Remarks

Claims 1-17 remain in the application and have been amended. Claims 8 and 17 have been amended to address the examiner's objections.

Figure 1 has been revised to revise the modem referred to as 13 to refer to it as 19. The other references in Figure 1 are all mentioned in the substitute specification. Examiner's office action indicated that reference character 13 was not mentioned in the original specification but applicant notes that it was mentioned at page 7, line 28 of the original specification. The other objections to the drawings are addressed via the changes made in the substitute specification, without addition of any new matter. The applicant respectfully submits that the means for accomplishing the various things accomplished by the applicant's invention are all described in Figure 1 and the discussion with respect to same in the substitute specification, as well as in the system screen shots that make up the rest of the figures.

With respect to the substitute specification, revisions were made to refer to each figure's contents, although that was already present in the description of figures in the original specification. Additionally, the references to multiple figures in one instance in the original specification was for purposes of describing features that are commonly present in each such figure. The applicant respectfully submits that the substitute specification complies with 35 USC 112 first paragraph. Additionally, no changes were made to the abstract although the applicant was reminded of the abstract requirements in office action no. 1, as the original abstract complied with the requirements.

The Applicant notes the examiner's rejection of Claims 1, 6-11 and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,041,310 ("Green") in view of an article published in 1999 in the Journal of Consumer Marketing titled "*The Virtual Automotive Dealership Is It Time? Is it Legal?*" ("Urban") and respectfully requests reconsideration and withdrawal of said rejection in light of the following discussion.

The Applicant respectfully submits that Claims 1, 6-11 and 14-17 are not unpatentable under 35 U.S.C. 103 (a) over the patent and article cited. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and *not* based on the Applicants' disclosure. MPEP § 2143. "In determining differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP § 2141.02 (emphasis in original) (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)).

Green teaches a method and system for facilitating a transaction between a customer and an automobile dealership utilizing a kiosk for formulating customer queries of dealership automobile inventories and facilitating auto purchase and new lease transactions between dealers and consumers. Green does not teach, suggest or even mention any method or system for use between individual consumers that are existing lessees of used vehicles to transfer their used leased vehicles and the existing leases amongst themselves. Green teaches a system that does not address the needs of individuals that are currently vehicle lessees, that want to either get out of their current lease/leased vehicle or individuals that are looking to lease a vehicle for a shorter period of time that an automobile dealer may be willing to lease, or lease a used vehicle (most auto dealers and leasing companies do not offer or permit new leases of used vehicles), or prefer to assume another individual consumer's lease by dealing directly with the individual lessee

consumer, knowing the exact lease terms (because they have been previously negotiated and agreed to in the existing lease that is to be assumed by the transferee) rather than having to interact with an auto dealer (which can be time consuming and aggravating due to typical auto dealer tactics). The applicant respectfully submits that the prima facie case of obviousness is not met in this case because the two cited references do not have any teaching or suggestion of systems for assignments of existing leases from one party to another and transfer of the used vehicle leased thereby.

Until the present invention, there has been no system or method for individual consumers to interact directly with each other electronically to transfer their existing vehicle leases and the used vehicles leased thereunder amongst themselves. Dealers would have no involvement in such transactions because auto dealers do not lease vehicles – they buy them and re-sell them. Dealers can use the present invention to broker individual consumer lease trades/vehicle assignments, but are not required as would be in other systems and methods in order to complete a transaction.

Individual consumers seeking to transfer their existing vehicle lease are normally required under the terms of their existing lease to remain liable for full payment and performance of the lessee's obligations under the terms of the existing lease even if those obligations are assumed by the new lessee. This presents a risk for the current lessee that can often cause the usual individual consumer current lessee to forego a lease transfer transaction. The present invention resolves this issue by also providing a facility easily accessible and incorporated into the electronic lease transfer method and system for current lessees to obtain insurance coverage against such risk. Most individual consumers would likely not have the contacts or resources to complete a lease transfer transaction without the applicant's system which brings the necessary insurance resource to the user's computer system rather than leaving the vehicle lessee to resolve this important transactional issue on his or her own.

Similarly, as examiner indicates, Urban teaches a virtual automotive dealership. However, the applicants system and method is not a dealership, but rather an online exchange, with no broker or dealer — consumers deal directly with each other. Examiner's statement that Urban teaches lease transfer is incorrect. Urban says nothing about dealerless transactions involving assignment of existing leases from one individual to another.

The applicant respectfully submits that the rejection set forth in office action no. 1 ignores any distinction between the transfer of a vehicle lease from one person to another (and the vehicle, which by virtue of it being the subject of an existing lease, must be used) and purchase or new lease of a vehicle from a dealer. In the applicant's invention, the existing lease is transferred with the payment amount and remaining lease duration term unchanged. There is no calculation of monthly payment amount.

Regarding the examiner's rejection of claims 2-5 under 35 USC § 103(a) as being unpatentable over Green in view of Urban further in view of Yahoo! Classifieds at Yahoo.com cited on January 28, 1999 ("Yahoo!"), for the reasons noted above, Green and Urban combined do not teach the applicant's system and method. Yahoo! shows ads — By Owner, New By Dealer, Used By Dealer — there is no mention whatsoever of "By Lessee".

Regarding examiner's rejection of Claims 12 and 13 under 35 USC § 103(a) as being unpatentable over the combination of Green and Urban in further view of Murphy et al., Patent Application Publication No. US2002/0051778, this again ignores the lack of a dealer in the applicant's system, which is a direct consumer-to-consumer transaction system.

As such, the prior art references noted do not teach or suggest all of the Applicant's claim limitations, and *prima facie* obviousness is not established.

The Applicant respectfully submits that its invention as claimed is not obvious in view of the patents cited by the examiner. The Applicant therefore respectfully requests that examiner withdraw the rejections of the Applicant's claims. The Applicant respectfully submits that the

application and claims are in condition for allowance. Nonetheless, should the examiner still have any comments, questions or suggestions, the examiner is respectfully requested to telephone the undersigned at the telephone number listed below.

Date: July 18, 2005.



Respectfully submitted,

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A handwritten signature in cursive script, appearing to read "Manuel R. Valcarcel", written over a horizontal line.

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